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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/878,806	06/11/2001	David A. Boeke	J&J-2025	3753

27777            7590            09/17/2003  
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EXAMINER
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MCCLELLAN, JAMES S

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 09/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/878,806	BOEKE, DAVID A.	
	<b>Examiner</b>	<b>Art Unit</b>	
	James S McClellan	3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 11 June 2001.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-23 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a)  The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                    | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                           | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>4.6</u> . | 6) <input type="checkbox"/> Other: _____ .                                   |

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-8, drawn to a method of ordering medical products over the Internet and requiring the allowance of a second user to request an order substantially the same as a previous order, classified in class 705, subclass 27.
  - II. Claim 9-23, drawn to a method of cooperative ordering medical supplies over a network and requiring a second client to authorize the order, classified in class 705, subclass 26.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as it may be used in a system that merely requires authorization without requiring the allowance of a second person to copy the order of a first person. See MPEP § 806.05(d).
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

5. During a telephone conversation with Michael Swope on 9/5/03 a provisional election was made without traverse to prosecute the invention of Group II, claims 9-23. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-8 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Information Disclosure Statement***

6. Applicant submission of Information Disclosure Statements on 12/7/01 and 3/5/02 is acknowledged and each signed/initialed PTO-1449 is attached.

***Claim Objections***

7. Claim 19 is objected to because it is unclear if Applicant intends to claim a method claim or an apparatus claim. Claim 19 depends from method claim 9, but is directed to computer-readable medium which is an apparatus. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 9, 10, 12, 14, 19, 20, and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,870,717 (Wiecha).

Regarding **claim 9**, Wiecha discloses a method for cooperative ordering of medical products over a network, comprising: providing a database (24) comprising information for purchasing a plurality of products; transmitting information for at least one product to a first client from said database of products (see column 3, lines 10-28); receiving from said first client a request to order said at least one product (see column 3, lines 29-37); storing said request to order said at least one product (see column 3, lines 29-37); and receiving from a second client an authorization to purchase said at least one product (see column 3, lines 29-37); **[claim 10]** the medical products comprise surgical procedure products; **[claim 12]** the network comprises the Internet (see column 7, lines 35-39); **[claim 14]** said product information comprises price information and wherein said price information is dependent on a customer account provided by one of said first and second client (see column 3, lines 13-16); and **[claim 19]** a computer-readable medium bearing instructions for carrying out the method of claim 9 (it is inherent that instructions to execute Wiecha's system are stored on a computer-readable medium).

Regarding claim 20, Wiecha discloses a system for cooperative ordering of medical products as described above in for method claim 1.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 12, 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiecha in view of Official Notice.

As alternative rejection, if it is held that Wiecha et al. fails to inherently disclose communication over the Internet utilizing web pages, then the Examiner relies on Official Notice that it was old and well known at the time the invention was made communicate information over the Internet utilizing web pages.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Wiecha with Internet communication as was well known in the art, because utilizing the Internet allows global communication, wherein increasing the potential for suppliers to contact customers.

12. Claims 11, 13, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiecha in view of U.S. Patent No. 5,991,728 (DeBusk et al.).

Regarding **claims 11 and 21**, Wiecha fails to expressly disclose an order comprising at least two products, wherein said two products are both used in a single medical operation.

DeBusk et al. teaches the use of medical product ordering system that discloses an order comprising at least two products, wherein said two products are both used in a single medical operation (see column 7, lines 21-22).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Wiecha with the bundling of medical products used in the same medical procedure as taught by DeBusk et al., because ordering in bundles will help to ensure that all medical products for a specific medical procedure are ordered together and are available to the health care professional at the time of the medical procedure. In contrast, ordering medical

products individually would have a larger chance of the overall order containing an ordering error.

Regarding claim 13, Wiecha fails to expressly disclose transmitting information for a second product wherein said second product is a substitute for said first product.

DeBusk et al. teaches the use of substituting products (see column 10, lines 18-23).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Wiecha with product substitution as taught by DeBusk et al., because providing a substitute product allows an order to be filled when the originally selected product is unavailable and thus reduces the time to reorder.

13. Claims 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiecha in view of U.S. Patent No. 5,970,474 (LeRoy et al.).

Regarding claims 15-17, Wiecha fails to expressly disclose transmitting information to a third client indicative of the request for order by the first client, wherein the user at the third client may submit an order based on the order by the first client and may add a product to the third client's request.

LeRoy et al. discloses a registry system for shoppers to purchase items selected by another user (see column 5, lines 41-51), wherein it is inherent that the shoppers to add additional items.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Wiecha with registry shopping feature LeRoy et al., because a registry allows a second customer to purchase a product previously selected by a first customer, when the second customer is unsure what products to order.

14. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wiecha in view of LeRoy et al. as applied to claims 15-17 above, and further in view of DeBusk et al.

Regarding claim 18, Wiecha in combination with LeRoy et al. fail to expressly disclose using the products in the same medical procedure.

DeBusk et al. teaches the use of medical product ordering system that discloses an order comprising at least two products, wherein said two products are both used in a single medical operation (see column 7, lines 21-22).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Wiecha's modified device with the bundling of medical products used in the same medical procedure as taught by DeBusk et al., because ordering in bundles will help to ensure that all medical products for a specific medical procedure are ordered together and are available to the health care professional at the time of the medical procedure. In contrast, ordering medical products individually would have a larger chance of the overall order containing an ordering error.

### ***Conclusion***

15. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

Engleson et al. is cited of interest for disclosing a system for collecting data and managing patient care.

Boppe is cited of interest for disclosing a surgical assistance and monitoring system.

McCay et al. is cited of interest for disclosing a method for marking, tracking, and managing hospital instruments.

Henley is cited of interest for disclosing a system for provision and acquisition of medical services and products.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jim McClellan whose telephone number is (703) 305-0212. The examiner can normally be reached on Monday-Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski, can be reached at (703) 308-5183.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Any response to this action should be mailed to:

Commissioner of Patent and Trademarks  
Washington D.C. 20231

or faxed to:

(703) 872-9326 (Official communications - Before Final);  
(703) 872-9327 (Official communications - After Final); or  
(703) 746-3516 (Informal/Draft communications).

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7<sup>th</sup> floor receptionist.

*James S. McClellan*  
James S. McClellan  
Patent Examiner  
A.U. 3627

jsm; September 12, 2003